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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Daniel A. Mendoza

v.

Stephen J. Hornung

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Opposition No. 91158348
to
Application Serial Nos. 78185701
(filed November 15, 2002)

and

Opposition No. 91158473
to
Application Serial No. 78187548
(filed November 21, 2002)[1]

Daniel A. Mendoza (pro se)

John Cain of Wong, Cabello, Lustch, Rutherford & Brucculeri, L.L.P. for Stephen J. Hornung

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Before Hairston, Zervas and Walsh, Administrative Trademark Judges.

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[1] These oppositions were consolidated by the Board's order of September 9, 2005, addressing opposer's motion to consolidate (filed December 1, 2004). On p. 2 of its consolidation order, the Board stated: "the decision in these consolidated proceedings [will] be rendered on the record in Opposition No. 91158473."

Opinion by Zervas, Administrative Trademark Judge:

Applicant, Stephen J. Hornung, seeks registration on the Principal Register of the marks 1-888-JUSTSAY[2] and 1-800-JUSTSAY[3] both in standard character form and both for the following services, "telecommunication services, namely, providing voice-activated communications through landline and wireless communications devices" in International Class 38.

Opposer, Daniel A. Mendoza, filed timely notices of opposition to registration of both of applicant's marks. In the notices of opposition, opposer pleads that he is the owner of Registration No. 2597355 for the mark JUST SAY* in standard character form for "dissemination of advertising for others via telephones and an on-line electronic communications network" in International Class 35; and "entertainment in the nature of prerecorded messages in the fields of arts and humanities by telephone and a global computer network" in International Class 41.[4] Further, opposer alleges that applicant's mark, as applied to the

[2] Application Serial No. 78185701, filed November 15, 2002, claiming an intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 USC §1501(b).
[3] Application Serial No. 78187548, filed November 21, 2002, claiming an intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 USC §1501(b).
[4] Registration No. 2597355, issued July 23, 2002. The mark is depicted as:

JUST SAY *

services identified in the application, so resembles opposer's previously-used and registered mark JUST SAY* as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant answered the notices of opposition by denying the salient allegations thereof. Applicant did not take any testimony or submit any evidence in this proceeding. The case was fully briefed and neither party requested an oral hearing.

Evidentiary Matters

At the outset, we discuss several evidentiary matters. Two motions are pending in this case, namely, applicant's "Motion to Strike Opposer's Asserted 'Evidence,'" that is, opposer's notice of reliance on opposer's own responses to applicant's discovery requests (opposer's responses to applicant's first set of interrogatories, first set of requests for admissions, first set of document requests and documents produced in response to applicant's first set of document requests), and opposer's "Motion to Quash Defendant's Motion to Strike," filed with opposer's reply brief.

We first turn to opposer's "Motion to Quash Defendant's Motion to Strike." Opposer contends that applicant's motion "is in the improper form" because applicant's motion appears within applicant's brief; and that "[e]very motion must

embody or be accompanied by a brief," citing Trademark Rule 2.127(a), 27 C.F.R. 2.127(a). Motion at p. 2. Opposer's motion is denied - while the Board prefers that a motion be filed as a separate paper and not within a brief, this is by no means a requirement for all motions. Also, because applicant has briefed its motion within its main brief, it has satisfied Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a).

With respect to applicant's motion, we find it is well taken - a party may not make its own discovery responses of record by notice of reliance, except in certain circumstances, none of which apply in this case. Trademark Rule 2.120(j)(5), 37 C.F.R. § 2.120(j)(5). See also, TBMP § 701.10 (2d ed. rev. 2004). Thus, applicant's motion to strike is granted as well taken and we have not considered opposer's discovery responses in rendering our decision in this case.

Next, we address the two-page document attached to opposer's brief entitled "Evidentiary Objections" in which opposer states as follows: (i) "Applicant's exhibits submitted did not include a Notice of Reliance 37 CFR 2.120 or [sic] Testimony Declarations"; (ii) "Applicant's Discovery responses to Opposers [sic] were often uncooperative and failed to answer Opposer's Discovery requests even with a minimal amount of professional courtesy and decorum, per Authority or Statute"; and (iii) "Opposer

requested information that is not subject to reasonable dispute or that is capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." Because applicant did not file any evidence during its trial period, opposer's "Evidentiary Objections" are given no further consideration.[5]

The Record

The record consists of the pleadings and the file of each involved application. Also, pursuant to opposer's notices of reliance, opposer has introduced the following into evidence: a status and title copy of opposer's pleaded registration and of Registration No. 2738851 for the mark "V (in standard character form)[6] showing opposer as the owner of record of both registrations and that the registrations are subsisting; a copy of applicant's responses to opposer's first set of requests for admission;[7] and a copy of

[5] If opposer intended its "Evidentiary Objections" as a motion to seek further responses to opposer's discovery requests such as a motion to determine the sufficiency of applicant's responses to opposer's requests for admission under Trademark Rule 2.120(h), opposer's motion is denied as having been filed well beyond the time permitted for filing discovery motions. Trademark Rules 2.120(e) and 2.120(h), 37 C.F.R. §§ 2.120(e) and 2.120(h). See also TBMP §§ 523 and 524 (2d ed. rev. 2004).

[6] Registration No. 2738851, issued July 15, 2003. The mark is depicted as the letter "V" preceded by a double quotation mark.

[7] Opposer's first set of requests for admission consists of 405 requests. A proceeding such as this one - which only involves the registrability of two similar marks and has no counterclaims - does not require such a large number of requests for admission. Many of opposer's requests for admission are irrelevant to the issues in this case. See, e.g., Request for Admission No. 30, which states "Applicant does not believe that Irreparable Harm is inevitable, even over time."

applicant's responses to opposer's first set of interrogatories.

Priority

In view of opposer's ownership of a valid and subsisting registration for the pleaded mark JUST SAY*, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue remaining for decision in this case is whether there is a likelihood of confusion.

Burden of Proof

Opposer, as plaintiff in the opposition proceeding, bears the burden of proving, by a preponderance of the evidence, that there is a likelihood of confusion. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

Discussion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed.

Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co*., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The salient question to be determined is not whether the involved services of the parties are likely to be confused, but rather whether there is a likelihood that the relevant purchasing public will be misled to believe that the services offered under the involved marks originate from a common source. See *J.C. Hall Company v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435 (CCPA 1965); and *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc*., 190 USPQ 25 (TTAB 1976).

We begin our analysis by considering the second *du Pont* factor, i.e., the similarities or dissimilarities between opposer's and applicant's services. It is important to note that we must compare the services as they are described in the applications and the registration in determining whether there is a likelihood of confusion. *Octocom Systems, Inc. v. Houston Computers Services Inc*., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

First, we note that perhaps other than Registration No. 2738851, opposer has not cited any evidence which is properly of record to show that the services are related. (The evidence opposer relies on to show a relationship between the services comprises the subject of opposer's improper notice of reliance on documents opposer produced in response to applicant's discovery requests.) However, Registration No. 2738851 for the mark "V for “telephone communication services,” which is of record, is entitled to little, if any, probative value in determining whether there is a similarity between applicant's and opposer's services.[8] Although opposer may offer both types of services identified in its registrations, the “telephone communication services” are offered under a mark different from the one identifying opposer's other services. Also, the "V mark is in no way similar to applicant's applied-for mark, and the registration is not evidence that the mark is in use or that purchasers are familiar with the mark.

Thus, we must compare the services as they appear in opposer's JUST SAY* registration and the involved

[8] Opposer states that he “has used the registered mark "V … in association with the mark JUST SAY* in connection with its Telecommunication service phone numbers, advertising, and voice-activated information services; available by landline or wireless device”; and that the “[m]ark "V … also solicits the same consumer trade-channels and base.” (Brief at pp. 9 and 10.) In his reply, opposer states that “the Registration for [the] mark "V … embodies Telephone use as well.” (Reply at p. 2.)

application. In doing so, we find that there is an important difference. Opposer's services are characterized as entertainment and advertising services, intended obviously as entertainment and to promote the goods and services of others, while applicant's services are telecommunications services – for communication purposes - which use voice activation.[9] Clearly, the nature of each service is different.

Opposer, in arguing that the services are similar, maintains that both parties offer "information and advertising services over [the] [t]elephone, both using voice-activated or voice recognition equipment, [and] … no cost [calls] to [the] calling party by way of Toll-Free Telephone Numbers." Reply at p. 7. Simply because a telephone, voice activated or voice recognition equipment and toll-free phone numbers are used in performing the services does not mean that the services are similar in the context of the likelihood of confusion analysis.

Opposer also makes an expansion of trade argument. Specifically, opposer contends that the "Opposer has

[9] In response to opposer's Interrogatory No. 7 which asked for a description "with particularity [of] the Telecommunication services you intend on offering," applicant responded "Horning identifies voice-activated telephone directory services accessible through the telephone number 1-800-587-8729." Also, applicant admitted opposer's Request for Admissions No. 142, which stated "Applicant will offer mark 1-800-JUSTSAY as a 'One' number to call, substituting an Office or Business numeric Telephone number."

expanded to voice-activated toll-free numbers," citing to exhibits which are the subject of applicant's motion to strike and which we have stricken above; and that the "[m]ark JUST SAY* has expanded to voice-activated services via the telephone for landline and wireless devices." (Brief at pp. 9 and 10. See also Brief at p. 5 ("Plaintiff … has expanded the marks use[d] to include voice-activation and toll-free numbers, and will continue to expand the channels-of-trade and the marks extensions.")). Because there is no evidentiary support for opposer's contentions, opposer's arguments regarding expansion are not well taken.

Thus, opposer has failed to persuade us that the parties' services are related. Absent any evidence suggesting that these services are related, and in view of the different nature of applicant's and opposer's services, we conclude that the services are not related and resolve the second *du Pont* factor in applicant's favor.

We next consider the third and fourth *du Pont* factors, i.e., the channels of trade and the prospective purchasers of the parties' services. In support for his contention that the trade channels and purchasers are the same, opposer relies on documents he produced in response to applicant's discovery requests, which we do not consider for the reasons set forth above. In his brief, opposer concludes that "[t]he consumers are [a]like and related in the trade

areas." (Brief at p. 10.) Applicant, in his response, maintains as follows:

> Applicant's services are directed to consumers who are seeking directory assistance and assistance with dialing through a voice-activated communications portal. Applicant's consumers call the telephone number associated with Applicant's mark to access Applicant's services. On information and belief, Registrant's services are directed to internet or telephone users who may or may not be seeking any particular services. (Brief at p. 6.)

Additionally, in response to opposer's Interrogatory No. 17 which sought the identity of applicant's "marketing or trade channels," applicant responded, "any and all traditional marketing and advertising mediums, including direct marketing, the Internet, trade shows, print media and partnering." In response to opposer's Interrogatory No. 5, applicant identified his "prospective client base" as "businesses who utilize telephone directory services."

Since applicant's services are not otherwise restricted, it must be presumed that they travel through all trade channels suitable for services of that type. The same is true with respect to opposer's services as recited in the pleaded registration. The determinative question, then, is whether the ordinary and usual trade channels and classes of customers for the respective services overlap under circumstances where confusion would be likely for purposes of Section 2(d) of the Act.

Certainly, it is likely that both parties would use direct marketing, the Internet, and print media to offer their services. However, there is no evidence of record that opposer and applicant would offer their respective services in the same location, under the same Internet marketing sites or be listed in the same Internet directories. Further, there is no evidence that the parties would use the same print media or the same manner of direct marketing to offer their services, which have very different purposes.

With respect to prospective purchasers, because the identifications of services are unrestricted in terms of purchasers, we find that both sophisticated purchasers such as businesses and unsophisticated purchasers such as ordinary consumers would use both parties' services.

We are satisfied in this case that while the parties' purchasers may overlap and that both parties have unsophisticated purchasers as potential purchasers, the respective services, by their very nature, are very different and advertised in different trade channels. Also, as noted above, opposer bears the burden of proof in this opposition. We thus resolve the third *du Pont* factor in applicant's favor and find that the fourth *du Pont* factor neutral.

We now consider the first *du Pont factor*, i.e., the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The general impression of applicant's marks – based on the numerals and dashes in the marks and the number of letters in the marks - is that the marks are phone numbers, and more specifically, toll-free phone numbers, that incorporate JUSTSAY, which is comprised of the two English language words “just” and “say.” Because the numerals and dashes in toll-free phone numbers have no or minimal source indicative function in and of themselves, we find that the dominant portion of applicant's marks is the wording JUSTSAY.

Opposer's registered mark is JUST SAY*. When spoken, we find that the purchasing public would pronounce the mark as “just say star” or “just say asterisk.” Applicant maintains that the mark may also be pronounced as “just say,” which is not unreasonable in view of the uncertain meaning of the “*” in the mark. In terms of the meaning of the mark in its entirety, applicant postulates that the mark “gives the impression of a three word phrase in which the third word is either variable or is omitted.” Opposer has

not contested this assertion, and it appears reasonable to us. We add, however, that in the context of opposer's identified services which could involve entertainment or advertising by means of the spoken word such as by telephone or even voice messages transmitted on the Internet, the "*" could signify a phrase or even the "*" button on a telephone keypad. Thus, because the third word or missing phrase is not identified, and because "JUST SAY '*' button on the telephone keypad" has no apparent meaning, we find that the meaning of the mark is "just say." In terms of appearance, the wording JUST SAY dominates the mark, in part because of the number of letters that form the phrase, JUST SAY versus the single character "*"; and in part because the wording is the only portion of the mark that has any apparent meaning and the likely portion that would be used in calling for the services. Thus, we too conclude that the wording JUST SAY is the dominant portion of opposer's registered mark.

Because the dominant portions of the marks are the same in the involved marks, we find that the marks are similar, at least in meaning and commercial impression. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (for rational reasons, more or less weight may be given to a particular feature of a mark, provided that the ultimate conclusion rests on a consideration of the marks in their entireties.) In finding that the marks are similar,

we have kept in mind that the proper test in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the overall similarities and dissimilarities engendered by the involved marks.

In view of the foregoing, we resolve the first *du Pont* factor in opposer's favor.

Conclusion

We have found above that the first *du Pont* factor favors a finding of likelihood of confusion, the fourth *du Pont* factor is neutral and the second and third *du Pont* factors favor applicant. In our view, however, the key *du Pont* factor in this case concerns the similarity or dissimilarity of the services, and this factor favors applicant. It was opposer's burden to establish a likelihood of confusion by a preponderance of the evidence, and most of opposer's evidence was not properly made of record and has been stricken, leaving opposer with minimal or no evidence in support of its allegations. We cannot base a finding of a relatedness of services on mere speculation.

Thus, although the parties have similar marks, we find, based on this record, that opposer has failed to prove that applicant's services are sufficiently related to opposer's services that confusion is likely. When we consider all the

du Pont factors on which there is evidence, we find that opposer has not shown by a preponderance of the evidence that confusion is likely. Accordingly, we dismiss the opposition on the ground of likelihood of confusion.

DECISION: Both oppositions are dismissed.